

REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of May 7, 2004 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

The Examiner has rejected claims 1-10 and 13-22 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,330,320 to Cornell *et al.* (Cornell). The Examiner has rejected claims 1-22 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application 2002/0118810 to Akhteruzzaman *et al.* (Akhteruzzaman). Additionally, the Examiner has rejected claims 11-12 under 35 U.S.C. § 103(a) as being unpatentable over Cornell in view of Akhteruzzaman.

In response to the 35 U.S.C. § 103(a) rejection, Applicants have enclosed affidavits under 37 C.F.R. § 1.131 supporting the removal of Akhteruzzaman as a reference. The affidavits are accompanied by a copy of the Applicants' confidential invention disclosure entitled "Remote Setup of third party calls as a Telephony Service". The confidential invention disclosure and affidavits demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as February 09, 2001, which predates the effective date of Akhteruzzaman of February 26, 2001. Applicants further exercised due diligence from prior to the effective date of Akhteruzzaman until February 19, 2002, the filing date of the instant application. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection with respect to claims 11-12 is respectfully requested.

Applicants have amended claims 1 and 13 to clarify that the directory access number linked to a telephony application that provides a call interrupt and 3-way calling function is different from the called access number (telephone number of the person currently engaged in a call with a second party.) The caller can establish a connection with the telephony application via the access number linked to the telephony application after receiving a busy signal upon dialing the called access number. Support for this amendment can be found in claim 6, in FIG 3 (items 305, 310, 320, 325, 340, 355) and within the specification. Applicants have also amended claims 11 and 12 to clarify that the third party is provided with the 3-way calling function via a

directory access number other than the target parties directory access number. Support for this amendment can be found in FIG. 2, in FIG 3 (items 305, 310, 320, 325, 340, 355) and within the specification. No new matter results from these claim amendments.

Prior to addressing the rejections on the art, a brief review of the Applicants' invention is in order. The Applicants' claimed and disclosed subject matter provides for the remote setup of third party telephone calls. The invention details an intercept service that when called, permits callers to impose themselves into an existing telephone conversation, thereby establishing a 3-way conference call. The intercept service can require a caller utilizing the service to provide authorization information, such as a password. The intercept service can interact with a plurality of telecommunication providers switches, thereby adding a 3rd party intercept telecom feature without requiring telecommunication service providers alter hardware/software and without requiring customers purchase customer premise equipment (CPE) to add the feature.

Turning to the rejections of the art, in paragraphs 1-2, the Examiner has rejected claims 1-10 and 13-22 under 35 U.S.C. § 102(e) as being anticipated by Cornell. Cornell discloses a method for allowing participants of a prescheduled conference established using local branching equipment to enter the conference without knowing the directory number of the conference. The method of Cornell uses a database that establishes conference calls in advance using identified hardware and identified conference call participants. The teachings of Cornell (which rely on database lookup) cannot be implemented without prior knowledge of the participants. That is, when a participant (like the third party of the Applicant's invention) is not known ahead of time, the method of Cornell cannot function.

Specific steps claimed by the Applicants that Cornell fails to teach include:

(1) determining that a called party is engaged in an existing telephone call, responsive to a telephone call initiated by a third party to a directory number of a called party)

– Cornell teaches a number associated with a conference bridge is to be called and fails to determine whether a prescheduled conference call is in progress.

(2) establishing a telephony connection between the third party and a telephony application;

- Cornell is silent as to a telephone application (software) and instead relies upon dedicated conferencing hardware having numerous previously reserved ports.

(3) receiving the directory number of the called party from the third party;

– Cornell teaches a directory number is not to be provided. Plus the directory number is not linked to a called party in Cornell, but to a conferencing hub number.

When comparing the Cornell reference with the Applicants claimed invention it becomes apparent that Cornell is not remotely similar to the Applicants invention. Applicants provide a hardware independent mechanism for an authorized individual to establish a 3-way call with a telephone call already in progress. In one embodiment, the Applicants invention is intended as an added service made generally available to customers and telephony service providers.

Cornell is an extension to a hardware dependent conference call infrastructure that includes at least one conference bridge 26, each bridge being associated with a directory number that participants can dial to enter a conference call established by the conference bridge 26. Cornell permits callers to access the right bridge 26 without knowing the hub access number for the hub that establishes the conference call. (NOTE: column 3, lines 32-65 detail that conference call features rely upon the access switching system 16 routing calls to particular conference bridges 26, each of which are reserved for conference calls.)

Cornell requires a conference be established ahead of time, with known parties. The Applicants invention permits a new party to enter an existing call, when none of the participants to the joined call were necessarily aware of the impromptu conference call ahead of time. In fact, in FIG. 3, the third party joining the call attempts to first contact a participant only to discover the phone line is busy. After receiving a busy indication, the directory number linked to an application providing the 3-calling feature is entered.

The present invention **requires** a third party to enter a directory number of a current call that the third party wishes to join. According to Cornell a party entering a conference call EXPLICITLY does not enter a directory number associated with the call. (See column 2, lines 10-13; column 2, lines 64-66; claim 1 [second receiving step]).

In light of the above, Cornell fails to anticipate the Applicants claimed invention. Moreover, Cornell fails to suggest the Applicants invention and actually teaches away from it. Accordingly, the 35 U.S.C. § 102(e) rejections to claims 1-10 and 13-22 under 35 U.S.C. § 102(e) based on Cornell should be withdrawn, which action is respectfully requested.

Referring to the second grounds for rejection, the Examiner has rejected claims 1-22 under 35 U.S.C. § 102(e) as being anticipated by Akhteruzzaman. Akhteruzzaman discloses a telephone barge-in capability that associates two directory numbers with a single telephone line; one representing a standard number; the other representing a priority number. Both directory numbers are considered by a telephony switch to have the same line identifier. In attempting to initiate a call, a callee using the standard number will receive a busy signal when the identified line is busy. When the identified line is occupied and the callee uses the priority number, the callee will be permitted to barge-in the line. Because the priority number and the standard number both are linked to the same line identifier, the invention taught by Akhteruzzaman is dependent upon the telephony switch in which it functions.

Referring to claims 1-22, Applicants claim connecting a third party to an existing telephone call so as to create a conference call (See connecting step in each independent claim "connecting said third party with said existing telephone call <between two other people.>" Akhteruzzaman is silent with respect to 3-way calls and fails to provide any teaching pertaining to their establishment. Instead, Akhteruzzaman discloses permitting a third party to barge-in an existing conversation, thereby breaking the telephone connection between a first party and a second party to establish a new connection between the first party and a new third party. For this teaching, Applicants refer the Examiner to the last sentence of paragraph 6, Akhteruzzaman states "The other call may be placed on hold, or, alternatively, may be disconnected with or without an announcement."

Further, Akhteruzzaman teaches dialing a priority access number associated with a party. Applicants teach that a directory number linked to an application (explicitly not associated with a desired party) is to be dialed before the 3-way calling feature provided by the application can be used.

Appln. No. 10/078,623
Amendment dated Aug. 9, 2004
Reply to Office action of May 7, 2004
Docket No. BOC9-2001-0008 (244)

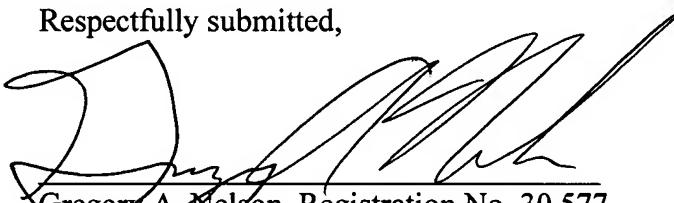
Additionally, after dialing the application linked directory number, a caller is prompted to enter a desired parties' telephone number. Akhteruzzaman provides no such teaching. Consequently, Akhteruzzaman fails to anticipate the Applicants claimed invention and the 35 U.S.C. § 102(e) based on Akhteruzzaman should be withdrawn, which action is respectfully requested.

The other art on record including Kung, Harrison, Henderson, Cannon, Maciejewski, Svercek, Ryan, and Mani referenced in the Office Action fails to singularly or in combination teach or suggest the Applicant's invention as claimed. Specifically, none of the references singularly or in combination teach or suggest providing a method through which a third party can cause themselves to be added to an existing telephone conversation, by dialing a directory number linked to an application, where the application first authorizes the third party to join the existing conversation, then causes the third party to be joined.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: 8/9/04



Gregory A. Nelson, Registration No. 30,577
Richard A. Hinson, Registration No. 47,652
Brian K. Buchheit, Registration No. 52,667
AKERMAN SENTERFITT
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000